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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,214	08/03/2000	Joseph M. Cannon	Cannon-104-93-51	1174
20736	7590	02/21/2006	EXAMINER	
MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			ARANI, TAGHI T	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/632,214	CANNON ET AL.
	Examiner	Art Unit
	Taghi T. Arani	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 December 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 20-31 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 and 20-31 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

1. Claims 1-10, 20-31 are pending for examination.

### **Continued Examination Under 37 CFR 1.114**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.14. Applicant's submission filed on 12/07/2005 has been entered.

#### *Response to Amendment*

3. Applicant's arguments filed 12/07/2005 regarding the rejection of the claims 1-10, 20-31 have been fully considered but they are not persuasive. Applicant's attempt to distinguish the claims from prior art is based on noting the lack of a teaching of "compare, at the near end, a near end password with a far end password entered after communications between a near end fax and a far-end fax have begun" recited in independent claims 1, 20, and 26.

This feature was found to be taught by CPA (JP 10-070528, page 2, paragraph 007] disclosing "when performing confidential transmission, beforehand a confidential transmitting notice is performed to a receiving side, the reply of a password is received from a receiving side, and a transmitting side starts confidential transmission, after it checks that it is in agreement with the password which this password registered beforehand."

The Examiner is attempting to clarify the teachings of the prior art reference and how it reads on the claims. In order for the applicant to have ample opportunity to provide perusasive

arguments and /or amendment of the claims to overcome the prior art of record this office action is made Non-Final.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8-10, 20-21, 23-27, 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by prior art of record, JP 10-070528, published March 1998.

**As per claims 1, 20 and 26 , JP 10-070528 teaches method and device for controlling a facsimile transmission of confidential information comprising (see Abstract):**

a comparison unit adapted to compare, at a near end, a near end password with a far end password entered after communication between a near end fax and a far-end fax have begun [Page 2, Detailed Description, Paragraph 007, the password which identifies a receiving side (far end) beforehand is registered into the transmitting side (near end) in performing confidential transmission), and when performing confidential transmission, beforehand a confidential transmitting notice is performed to a receiving side, the reply of a password is received from a receiving side, and a transmitting side starts confidential transmission , after it checks that it is in agreement with the password which this password registered beforehand, see also paragraph 0014); and

encrypting said facsimile [page 4, Detailed Description, second paragraph, CPU1 performs coding/decryption (encryption)]

a transmission unit adapted to allow (authorizing) transmission of confidential information to a far end if said a near end comparison of said a near end password with said a far end password, results in a match [same paragraph, when performing confidential transmission, beforehand, a confidential transmitting notice is performed to a receiving side, the replay of a password is received from a receiving side and after it checks that the password is in agreement with the password registered beforehand the transmitting side starts confidential transmission].

**As per claim 2**, JP 10-070528 teaches the device comprises:

a facsimile machine [Page 4, Detailed Description, first paragraph, see also Fig. 4].

**As per claim 3**, JP 10-070528 teaches the device comprises:

a PC modem [Page 4, Detailed Description, second paragraph, Fig. 4, Modem 10 (equipped with the data modem function other than the conventional FAX modem function)].

**As per claim 4**, JP 10-070528 teaches the device comprises:

a chipset [page 4, Detailed Description, second paragraph, Fig. 4, DRAMs (Image memory 8)].

**As per claim 5**, JP 10-070528 teaches the device comprises:

a digital signal processor[page 4, Detailed Description, second paragraph, Fig. 4, DSU 9].

**As per claims 6, 8, 21, 23, 27 and 29**, JP 10-070528 teaches the device, further comprising: an encryptor/decryptor adapted to encrypt/decrypt the confidential information [page 4, Detailed Description, second paragraph, CPU1 performs coding/decryption (encryption)].

**As per claims 9, 24 and 30**, JP 10-070528 teaches the device further

comprising:

a signal module adapted to generate a notification signal upon receipt of a password request signal [Page 2, paragraph 007 discloses when performing confidential transmission, beforehand, a confidential transmitting notice is performed to a receiving side, the replay of a password is received from a receiving side, and a transmitting side starts confidential transmission. (i.e., generating a notification signal by the device to start confidential transmission)].

**As per claims 10, 25 and 31, JP 10-070528 teaches the device comprising a signal module adapted to generate a distribution request signal to prompt a far end user to enter distribution instructions [Page 2, MEANS, paragraph 0016 (Request to Send signal)].**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 7, 22 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-070528 as applied to claims 6 and 21 above, and further in view of Schneier, Applied Cryptography (cited in previous office action).

JP 10-070528 fails to teach the encryption process is a PGP encryption. Schneier teaches that the PGP encryption process is very secure encryption protocol, which is well suited for ANSI messages (pgs 584-587). The PGP encryption process is much more secure than the encryption process used by JP 10-070528. It would be advantageous to improve the level of encryption. In view of this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Schneier within the system of JP 10-070528 because a higher level of encryption would decrease the chance that a malicious user could decrypt the encrypted fax.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Examiner

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2/9/2006